

## REMARKS

Claims 1-20 are under consideration. Claims 1,2 and 12 are amended.

Reconsideration of claims 1 and 12 and dependent claims thereof is respectfully requested.

### 35 U.S.C. § 103 Rejections

In paragraphs 3-7 of the Final Action and paragraph 2 of the Office Action mailed 3/22/2004, the Action has rejected claims 1-7, 10 and 12-17 as being unpatentable over *Foley et al* (US Patent No.3,484,106, issued on December 16, 1969).

*The Action states in paragraph 2: The patent to Foley et al discloses a game system comprising a plurality of bases 35, Figs 4 and 5, column 2, lines 69-71. Each of these bases has educational graphics or numerals "1" to "12", column 2, line 72 to column 2, line 1. In Foley's disclosed embodiment, cards 39 numbered from "1" to "12" corresponding to the numerals on the bases, column 3, lines 5-7, are used as a chance device. Foley also discloses that the chance device may dice instead of cards, column 4, lines 1-3. Thus the numerals "1" to "12" on the bases are reproduced on the sides dice. Foley dose not disclose the number of sides on the dice, but it is inherent that Foley uses a 12-sided dice. To play Foley's game each player is given four bases and stands on the bases. The dice is cast to show a numeral. The base having the numeral corresponding to the numeral on the cast dice is eliminated, ,column 3, lines 9-14. The dice is recast and another base is eliminated, this is repeated until a sole winner is identified standing on the same base numeral as the latest case of the dice, column 3, lines 16-26.*

*The only feature recited in claims 1-7 and 12-17 that Foley lacks is N sided dice and “(P-1) X N bases where P is the number of players”. Foley only recites an embodiment having three players and each player has four bases for a total of twelve bases and a twelve sided dice is used. It would have been .....Determining the number of bases and the number of sides of a dice would simply been a manufacturing design choice, which is always obvious in the art.*

*The Final Action States in paragraphs 3-7, that “The Examiner takes the position that by replacing the word “dice” with “randomizer” the applicant actually broadened the claims.....Similarly by replacing the word “bases” with the word “objects” the applicant actually broadened the claims.”*

In response to above paragraphs, applicant disagrees. This is because if the information cited above from Foley would make the present invention obvious, then this information would comply with the unique feature of the present invention, that is,

For 3 players in Foley ( $P=3$ ); and for a 12 sided dice ( $N=12$ ); therefore, the number of bases according to the present invention would be:

$(P-1) \times N \text{ bases} = (3-1) \times 12 = 24 \text{ bases}$ . However, Foley has only 12 bases.

That is Foley teaches away from the present invention.

Applicant disagrees that determining the number of bases and the number of sides of a dice would simply be a manufacturing design choice, because in the present invention, there will always be (P-1) number of bases of the same graphic. The number of different graphics will be N. Foley has different graphics 1 to 12 on the 12 bases, but

none of the 1-12 bases is in duplicates ( $P-1 = 3-1=2$ ), and therefore Foley again again teaches away from the present invention. Applicant has amended claims 1 and 12 to incorporate the above limitations.

Additionally, applicant has amended the claims to replace “randomizer” with “dice” and to replace “bases” with “objects”.

*The Final Action states in Paragraphs 6 and 7 that*

*1) “The Examiner takes the position that the claimed recitation “randomly arranging said objects” in claim 12 is a broad recitation invention.”*

*2) “The Examiner takes the position that the object of Foley’s game is similar to musical chairs in that as the mats are eliminated, the players are eliminated, the last player standing on a mat still on the ground wins the game, column 3, lines 21-26.”*

In response, claim 12 has been amended. As to 2) applicant would like to distinguish the present application by pointing out that the last player in Foley et al is left standing with one foot on the mat but in the present invention, the last player can have both his feet on the same mat.

Applicant refers to MPEP 2141.02 and specifically points out that in determining the differences between the prior art and the claims, the question under 35 USC 103, is not whether the differences themselves would have been obvious, but whether the

claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp. 713 F. 2d 1530 218 USPQ 871 (Fed. Cir. 1983).

The Action cites Foley et al for describing the dice. However, Foley et al describes a dice “as a chance selection device (in teams, the high roll winner or individually, the number thrown tells which mat is removed). Foley et al neither suggests or teaches the present invention which requires that the dice have N number of different graphics and each graphic should have P-1 copies. Furthermore, each graphic in the present invention serves a specific purpose – educational, etc.

Regarding the base shape, Foley et al teaches away from the shape requirements of the present invention. Foley et al actually requires the mats to be made into the first and second peripheral shapes, the first have four different shapes, said first shape having four edges, each of them being convex, and said second shape having four edges each of them being concave, said concave edges mating with said convex edges. Thus, as a matter of fact and law, the above rejection of claims 1-7, 10 and 12-17 cannot be sustained.

*In paragraph 2 of the March 22, 2004 Action, the Action rejects claims 4-6 and 14-16 because Foley et al discloses the claimed invention except for the geometric shapes, humorous graphics, and personalized graphics set forth in the claims. ...when the claimed subject matter is not functionally related to the substrate it will not distinguish the invention from prior art.... In re Gulack, 217 USPQ 401 (CAFC 1983).*

In response applicant submits that the different graphics in the present invention are not just different in print from Foley et al’s graphics of number 1 to 12. In the present invention, these graphics are different in shape and distinguishable from the shape of the mats in prior art having the convex-concave sides that mate. That is, in the present invention there exists a new and functional relationship between the shape of the bases

and the printed matter. Therefore, under Gulack, the present invention is distinguishable over Foley et al.

In paragraph 3 of the March 22, 2004 Action, the Action rejects claims 8-11 and 18-20 under 35 U.S.C. 103(a) as being unpatentable over Foley as applied to claim 1 and 12 in view of Sieve.(U.S. Patent 3,208,754), which teaches a differently sided dice in the game art. In paragraph 8 of the Final Action, the Action states that *"In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on a combination of references."*

In response, applicant disagrees, because there is improper rationale for combining Foley et al and Sieve. This is because Sieve describes that games "employing dice have become popular over the years but usually these involve complicated playing boards and other accessories and intricate rules." Therefore it is against teachings of Sieve to combine it with Foley et al. In any event, Sieve describes a tetrahedron that can be thrown like a dice. Moreover, since Foley et al, it self makes a reference to "dice" it is not necessary to find a reference for the dice. However, applicant has submitted arguments above regarding the novelty in applicant's invention, that the dice has N sides representing different number of graphics. This is neither taught or described in Foley et al or Sieve.

As a matter of law, the above rejection cannot be sustained. The Federal Circuit, in reference to references cited in an obviousness rejection, has held that:"The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention." Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 1986 MPEP 2141.

"To make a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. Second, there

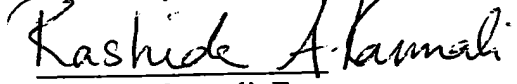
must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." In re Vaeck 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (MPEP §2143 and 2142).

" When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper". Ex parte Skinner, 2 USPQ 1788 ( Bd. Pat. App. & Inter. 1986).

In this regard, there is no teaching or suggestion whatsoever in Sieve of a game of a plurality of potable bases of the present invention. Therefore, as a matter of fact and law, there is no basis to sustain the rejection of any of the claims under consideration 8-11 and 18-20, as being obvious over Foley et al in view of Sieve. This rejection should be withdrawn.

If for any reason, the Examiner should deem this application not in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney to resolve any outstanding issues prior to issuing a further Office Action.

Respectfully Submitted,

  
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